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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,421

02/05/2002

Mei Chuah

426882005100

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05/31/2005

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/072,421

Applicant(s)

CHUAH, MEI

Examiner

Daniel S Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Receipt of the amendment filed February 23, 2005 is acknowledged. Claims 1-4, 9, 11-14, 19-20, 22, 25, 28, 30, 32-33, 35 and 41 have been amended and claims 47-55 have been added from the September 03, 2004 amendment. Claims 1-55 remain pending in the application and are presented to be examined based upon their merits.
2. Receipt of the Request for Continued Examination ("RCE") filed September 03, 2004 is also acknowledged. After the consideration of applicant's comments regarding the Election/Restriction is withdrawn.

### *Response to Arguments*

3. Applicant's arguments filed September 03, 2004 regarding claims 1-46 have been fully considered but they are not persuasive. The applicant has provided an amendment for claims 1-4, 9, 11-14, 19-20, 22, 25, 28, 30, 32-33, 35 and 41 which entail the size of each sub-portion being determined by the number of VC portfolio companies in corresponding sub-industry, etc., This amendment does not read over the previous Office Action(s) rejections using Marshall and Hatori because mere changes of size, degree, shape proportion, etc., are considered unpatentable [see *In re Rose*, 105 USPQ 237; *In re Aller et al.*, 105 USPQ 233; *In re Dailey et al.*, 149 45 USPQ 230]. As to previous assertions that applicant has made regarding the motivation that the examiner has chosen to use to combine Marshall and Hatori as based merely upon design choice, the examiner has stated that there may be alternatives relying upon as a functional art

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equivalent for the basis of rejection and not an obvious matter of design choice. The applicant should respectfully consider, however, that a change in the aesthetic (ornamental) design is not patentable [*In re Seid*, 73 USPQ 431]. Thus the rejections from previous Office Actions using Marshall and Hatori are maintained for claims 1-46. Claims 47-55 are addressed below.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US

Marshall discloses, as in claims 47-55, a method of tracking investment money via a virtual reality world to generate icons (metaphors) that represent various companies (i.e., industry “groups” and sub-groups; see Marshall, fig. 2, col. 12, ll. 36+), in various shapes, colors, positions, animations and textures (see Marshall, col. 6, ll. 10, to col. 7, ll. 30). Marshall fails to call these industry sub-groups “start-ups” per se. However, it would have been obvious for an artisan of ordinary skill in the art at the time of the invention to recognize that within a sub-group (or sub-groups) in any growing industry (or industry sector) there will be portions that represent small start-up companies which provide investors with investment opportunities to get in on the

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“ground floor” of a new company before it becomes a large, well sought after company. Thus it would have been considered an art recognized equivalent to the other industrial and financial instruments Marshal discloses, and thus an obvious expedient well within the ordinary skill in the art.

Regarding changes in size, color or shape of icons (see arguments provided in the response for arguments)

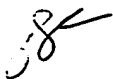
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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF  
May 25, 2005

Daniel S Felten  
Examiner  
Art Unit 3624

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

